

Remarks

Applicants have carefully reviewed and considered the Office Action mailed on March 16, 2001, and the reference cited therewith.

Claims 1, 4, 11, 13, 14, and 26-27, are amended, and claims 34 and 35 are added. Thus, claims 1, 3, 4, 11, 13, 14, 26-29, 34 and 35 are now pending in this application.

The amendment to claim 1 is supported at pages 9-10 of the specification. Claims 34 and 35 have been added to claim preferred embodiments. No new subject matter is added.

The Examiner has provisionally rejected claims 1, 3, 4, 11, 13, 14, and 26-29 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4-6, 10, 12, and 20 of co-pending U.S. Patent Application No. 09/360,020 (the '020 application). The rejection is provisional because the '020 application has not yet issued as a patent.

Applicants note that the claims of U.S. Patent Application No. 09/360,020 have not been allowed. The prosecution of the '020 application has been suspended. Thus, because this is a provisional rejection and the claims of the '020 application have not been allowed, it is respectfully requested that this rejection be withdrawn.

Claims 1, 3, 4, 11, 13, 14, and 26-29 were rejected under 35 U.S.C. § 112, first paragraph, on the basis that the specification does not reasonably provide enablement for the term "an analog." Rather, the Examiner alleges that specification "is enabled for the analogs disclosed." Insofar as this rejection may be maintained with respect to any of the amended claims, it is respectfully traversed.

Claim 1 has been amended to replace the term "etodolac or an analog thereof" with the generic formula shown on pages 9-10 of the specification. Therefore, withdrawal of this rejection is appropriate and is respectfully requested.

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Co-Pending Application

It is believed that one or more U.S. applications based on published PCT application WO 00/02555 (Nardella et al.) may be pending which may claim related subject matter. This PCT application is of record in the present application.

Although both chronic lymphocytic leukemia and multiple myeloma can be considered leukemias, it is Applicants' position that a disclosure that etodolac or an analog thereof may be suitable for treating chronic lymphocytic leukemia would not render a claim for treatment of multiple myeloma obvious. The etiology of these diseases is different. Thus, it is respectfully requested that the claims of the instant application pass to issue.

Conclusion

Applicants believe the claims are in condition for allowance and request reconsideration of the application and allowance of the claims. The Examiner is invited to telephone the below-signed attorney at 612-373-6968 to discuss any questions which may remain with respect to the present application.

Respectfully submitted,

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Date

April 29, 2002

By

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CERTIFICATE UNDER 37 CAR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, Washington, D.C. 20231, on this 29th day of April, 2001.

PATRICIA A. HULTMAN
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